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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,531	06/27/2006	Ray Davenport	PC/3-22342/A/PCT	4385

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Ciba Specialty Chemicals Corporation
Patent Department
540 White Plains Road
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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,531	Applicant(s) DAVENPORT ET AL.	
	Examiner Anthony J. Green	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Patent Specification No. CA 2214210 A.

The reference teaches, in the claims, an aqueous composition for paper coatings comprising 20-90% organic pigments, 1-30% binders and other optional components.

The instant claims are met by the reference. The organic pigment may be a plastic pigment. It is believed that the binders of the reference encompass those recited in claim 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian Patent Specification No. CA 2214210 A.

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The instant claims are obvious over the reference. While the primary reference does not recite the use of the same organic pigments it does broadly teach the use of organic pigments and accordingly it would have been obvious to utilize any well known organic pigments without producing any unexpected results absent a showing otherwise.

5. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luebke et al (US Patent No. 5,800,870 A) in view of Canadian Patent Specification No. CA 2214210 A.

Luebke et al teaches a method of coating paper by applying a paper coating composition comprising a binder and a pigment. The binder comprises a stable aqueous dispersion comprising a water insoluble component and a water soluble component such that the water insoluble component comprises coalescable polymer particles which have a T_g less than 55°C . and a majority of which have a particle size less than 1 micron; and the water soluble component comprises a water soluble polymer capable of inhibiting coalescence of said polymer particles, or a water soluble polymer and a component capable of inhibiting coalescence of said polymer particles; and wherein said water insoluble component comprises greater than 3% and less than 75% by weight of the binder solids and said water soluble component comprises greater than 25% and less than about 97% of said solids. According to column 5, lines 50+ the pigments useful include clay, calcium carbonate, plus others known in the art. Column 6, lines 4+, recite the ranges of the amounts of the components.

The Canadian reference was discussed previously.

The instant claims are obvious over the combination of the references. While the primary reference does not recite the use of an organic pigment it does teach that others known in the art may be utilized and since the secondary reference teaches that it is known to use organic pigments to coat papers it would have been obvious to incorporate an organic pigment into the primary reference without producing any unexpected results and thus arrive at the instant invention absent evidence showing otherwise.

6. Claims 1-2, 5-6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al (US Patent Application No. 2003/0047118 A1).

The reference teaches, in paragraphs [0016]-[0020] and [0029], an aqueous based organic pigment dispersion comprising (i) a silica binder in an amount of at least 10%; (ii) an organic pigment in an amount of at least 30%; and (iii) dispersing agent in an amount of 1-10% and (iv) remainder water. Paragraph [0027] teaches that the organic pigments are selected from phthalocyanine green, quinacridone etc.

The instant claims are obvious over the reference. As for the types of pigments the reference teaches types that encompass those recited in claim 2. As for the amounts, the reference teaches amounts that encompass that which are instantly claimed. However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and

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therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

7. Claims 1-2, 5-6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieling et al (US Patent Application No. 2003/0092833 A1).

The reference teaches, in paragraphs [0016]-[0021] a pigment paste comprising from 10 to 35% of polyurethane acrylate resin, from 10 to 65% water, from 18 to 40% of at least one organic pigment, from 30 to 80% of at least one organic opaque pigment and from more than 8 to 15% carbon black. Paragraph [0113] teaches that all organic and inorganic pigments are suitable in the paste including perylene, phthalocyanines etc.

The instant claims are obvious over the reference. As for the types of pigments the reference teaches types that encompass those recited in claim 2. As for the amounts, the reference teaches amounts that encompass that which are instantly claimed. However, one of ordinary skill in the art at the time the invention was made

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would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

8. Claims 1-2, 5-6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. JP59-089373A.

The reference teaches, in the abstract, an aqueous marker ink composition comprising 5-40 parts by weight of organic pigment, 10-40 parts by weight of titanium oxide and 10-50 parts by weight of binder resin.

The instant claims are obvious over the reference. As for the types of organic pigments it is the position of the examiner that absent evidence to the contrary any well known organic pigment useable in inks may be used without using any unexpected results and thus claim 2 is rendered obvious. As for the amounts, the reference teaches amounts that encompass that which are instantly claimed. However, one of ordinary

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skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to the types of binders that may be utilized. Note that claim 6 recites that binder resins may be used as auxiliaries and it is unclear as to how the 2 differ. Claims in which one component is defined so broadly that it reads on a

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second, fail to meet the requirements of the second paragraph of 35 USC 112. See *Ex parte Ferm et al* 162.

In claim 2 it is unclear as to the types of pigments encompassed by this claim.

In claim 3 the phrase “the binder solids” in line 8 lacks proper antecedent basis.

In claim 4 the term “i.e.” renders the claim indefinite because it is unclear whether the limitations following the term are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

In claim 5 it is unclear as to the types of dyes encompassed by the claim. That is, it is unclear as to those that are suitable for the dyeing of paper.

In claim 6 it is unclear as to how the binder resin differs from the binder of claim 1.

In claim 11 the term “i.e.” renders the claim indefinite because it is unclear whether the limitations following the term are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

In claim 13 it is unclear as to how the binder resin differs from the binder of claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J. Green/

Primary Examiner
Art Unit 1793

ajg
April 9, 2008